

REMARKS

Special Status

Applicant notes that this application has been pending for more than five years. Accordingly, the application is now entitled to special status as set forth in MPEP 708.

Claim objections

Applicant amends the claims to replace "disc" with --disk-- as requested. In addition, Applicant amends selected claims to correct punctuation.

Rejection based on 35 USC 112 second paragraph

On page 3, the Office Action states

"[i]t is not clear as whether the formal description of the file system is designed to include both a data structure and a non-data structure."

The claim language beginning at line 6 recites limitations on precisely what the formal description enables the client to do:

"the formal description of the file system enables said client to find and interpret at least one data structure that includes file information that enables the client to directly read and write data to and from said disk storage"

In particular, the foregoing claim language states two things that the formal description enables the client to do. These two things are:

- (1) the formal description enables the client to find a data structure that includes file information, and
- (2) the formal description enables the client to interpret the data structure that it has found.

The claim language following the preceding passage states exactly what the file information enables the client to do:

"file information that enables the client to directly read and write data to and from said disk storage"

Thus, the limitations on the file information are as follows:

- (1) the file information enables the client to directly read data from disk storage; and
- (2) the file information enables the client to directly write data to disk storage.

The claim ends with one additional limitation on the formal description, namely that

“the formal description of the file system lacks a data structure that includes file information”

Thus, according to the claim, the formal description may or may not include a data structure. But if the formal description includes a data structure, then that data structure may not have file information.

On page 3, the Office Action states that

“[i]t is not clear which data structure the applicant is referred to”

In fact, claim 1 clearly identifies the data structure as that data structure that includes file information. The claim specifically states:

“the formal description of the file system enables said client to find and interpret at least one data structure that includes file information that enables the client to directly read and write data to and from said disk storage”

The text following the underlined “that” defines exactly what data structure is referred to. In particular, the data structure being referred to is a data structure that includes file information. This file information enables the client to do two things:

- (1) the file information enables the client to directly read data from disk storage; and
- (2) the file information enables the client to directly write data to disk storage.

Applicant submits that it is quite clear, based on the foregoing, exactly what data structure is meant.

On page 4, the Office further states that “[t]he invention as claimed is teaching away from the purpose of the invention.”

Applicant is puzzled both by the content and the relevance of this statement. All section 112 requires is that the claim particularly point out and distinctly claim the subject matter that the Applicant regards as his invention. There is no requirement in section 112 concerning claims teaching toward or away from the purpose of an invention.

Finally, on page 4, the Office Action states that “[p]ronouns are not permitted.” Applicant request that the Office identify that portion of the CFR that states that no pronouns whatsoever are permitted in claims.

Rejection based on 35 USC 112 first paragraph

On page 4, the Office Action suggests that the limitation “wherein the formal description of the file system lacks a data structure that includes file information” is not enabled.

Nowhere does the description state that one should create a formal description that includes a data structure *with* file information. Therefore, one of ordinary skill in the art who reads the description and follows the instructions therein would create a formal description that does *not* have a data structure that includes file information, just as the claim requires. Therefore, the description enables the claim.

Section 103 rejection of claim 1

The Office Action proposes to combine *Soltis*, *Williams*, and portions of the Applicant's own disclosure to render claim 1 obvious.

The Office Action concedes that *Soltis* fails to teach the claim limitation “wherein the formal description of the file system enables said client to find and interpret at least one data structure that includes file information that enables the client to directly read and write data to and from said disk storage”

On page 5, the Office Action states that “*Williams* disclose a server based system that support the ability to preallocate space to a file at open time and while the file is in use (page 3, section 3).”

The actual text from *Williams* reads as follows:

“3.0 Simplifying Assumptions

1. Server-based File system/Volume Management data processing not currently supported

The initial release of the standard will only support data that has not been modified by the file system prior to being stored on disk, and does not support server-side software RAID.

2. Secure SANs

The initial release assumes that the SAN is physically secure, and that the clients accessing the shared disks over the SAN are trusted.”

The above text does not teach anything like what the Office Action says it teaches. It certainly has nothing to do with directly reading and writing data to and from disk storage. Nor does it say anything about who or what performs block allocation. In fact, the foregoing text from *Williams* is so irrelevant to the claimed subject matter that Applicant wonders if there has simply been a mistake.

The Office Action also concedes that *Soltis* fails to disclose the limitation: “wherein the formal description of the file system lacks a data structure that includes file information.” The Office Action proposes to remedy this deficiency in *Soltis* by combining it with certain “admitted prior art.”

On page 6, the Examiner identifies this allegedly admitted prior art at page 8, lines 16-17 of the specification. This text reads as follows:

“One alternative to a formal description is to use the algorithms actually needed to find and interpret the on-disk data structures.”

There is no apparent basis for asserting that the cited text is admitted prior art at all. The specification does not characterize this text as prior art. Nor is the text located in a portion of the

specification, such as the "Background", where one might expect to find prior art. Instead, the foregoing text is part of Applicant's detailed description. It is improper to use selected portions of Applicant's owned detailed description as prior art against the Applicant.

The Office Action also offers, as a motivation to combine this allegedly admitted prior art, the purpose of "providing the most expedient way to specify the file format." However, these are the very words Applicant uses in the specification on page 8, lines 23-24. Thus, not only does the Office Action propose to combine portions of Applicant's own detailed description to yield the claimed invention, the Office Action also uses Applicant's own specification to supply the motivation to make the proposed combination. This too is improper.

Accordingly, the section 103 rejection of claim 1 is improper. Independent claims 16, 20, and 25 include limitations similar to those of claim 1 and are therefore patentable for at least the same reasons.

Section 103 rejection of claims 33-36

The Office Action rejects claims 33-36 because of allegedly admitted prior art.

In response, Applicant submits that there is no basis for considering the cited text to be admitted prior art. The disclosure does not include any admission, express or implied, that the cited text is in fact admitted prior art. Moreover, the cited text does not appear in that portion of the application, namely the "Background," that would normally be reserved for prior art. Accordingly, Applicant submits that the Office has improperly cited excerpts of Applicant's own disclosure as prior art.

In addition, the motivation to combine the cited text with the remaining two references is itself drawn from Applicant's disclosure, and indeed appears to be an almost verbatim copy of Applicant's own words at page 8, lines 23-24. The motivation to combine references may not be obtained from Applicant's own disclosure. Accordingly, the section 103 rejection of claims 33-36 is improper.

Section 103 rejection of claims 37-40

Claims 37-40 recite a formal description that does *not* include an algorithm used to implement the file system.

The text on page 10 of the Office Action appears to ignore this fundamental distinction between claims 37-40 and claims 33-36. Not surprisingly, the Office proceeds to reject claims 37-40 as being obvious for exactly the same reasons proffered for claims 33-36.

It is clear, therefore, that claims 37-40 have not been properly examined.

Summary

Now pending in this application are independent claim 1, with its dependent claims 2, 3, 6-9, 33, and 37; independent claim 16 with its dependent claims 17-19, 34, and 38; independent claim 20 with its dependent claims 21-24, 34, and 39; independent claim 25, with its dependent claims 26-27, 36, and 40.

Applicant petitions for an extension of time under 37 CFR 1.136(a) and requests that the extension fee be charged to the deposit account listed below.

No additional fees are believed to be due in connection with the filing of this response. However, to the extent fees are due, or if a refund is forthcoming, please adjust our deposit account 06-1050, referencing attorney docket "07072-133001."

Respectfully submitted,

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